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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,997	11/06/2001	Michael S. Tignor	GEN-0286	4681

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EXAMINER

BENENSON, BORIS

ART UNIT PAPER NUMBER

2836

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/682,997

Applicant(s)

TIGNOR ET AL.

Examiner

Boris Benenson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Information Disclosure Statement***

Note that an applicant's duty of disclosure of material and information is not satisfied by presenting a patent examiner with "mountain of largely irrelevant [material] from which he is presumed to have been able, with his expertise and with adequate time, to have found the critical [material]. It ignores the real world conditions under which examiners work." *Rohm & Haas Co. v. Crystal Chemical Co.*, 722 F. 2d 1556, 1573 [220 USPQ 289] (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (Emphasis in original). Patent applicant has a duty not just to disclose pertinent prior art references but to make a disclosure in such way as not to "bury" it within other disclosures of less relevant prior art; See *Golden Valley Microwave Foods Inc. v. Weaver Popcorn Co. Inc.*, 24 USPQ2d 1801 (N.D. Ind. 1992); *Molins PLC v. Textron Inc.*, 26 USPQ2d 1889, at 1899 (D.Del. 1992); *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc. et al.*, 175 USPQ 260, at 272 (S.D. F.l. 1972).

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,13,25 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Leone et al. (5,490,086) or Murphy (4,958,252). Leone disclose an electrical trip unit (Fig.6, Pos. 14) having a microprocessor (15) to identify an ID number from a module plug (16A) having a display (Fig.5, Pos. 28) and operator interface (30) and access to one of the programs to control the module plug (Col. 3, Lines 9-30). "Memory 36 may take the form of dip switches, a set of jumpers (presently preferred embodiment), PROM or other types of ROM" (Col.3, Lines 12-14).

Murphy disclosed a circuit breaker with removable rating plug. The breaker includes a trip unit (Fig.1, Pos. 5) comprising a microprocessor (Fig.2, Pos. 27), trip mechanism (25), controlled by the microprocessor and a rating plug (7) releasably inserted into the trip unit. An EEPROM (55) provides the microprocessor (27) with maximum rated current, frame rate and other data, which are set by rating plug. The microprocessor invokes the program according to the data, received from EEPROM through DO (Pin 10), evaluates received data and controls the trip mechanism. The EEPROM memory includes four registers (Fig.3) storing service data on the circuit breaker. "The first register (57) records the style or model of the circuit breaker.

The second register (59) records the serial number of the breaker. Register (61) records the trip history of the circuit breaker, which is the number of trips weighted by a function of the current interrupted by each trip. Finally, the register (63) records the number of operations of the operating mechanism of the circuit breaker" (Col.5, Lines 6-15). A separate programmer device allows reading, writing and displaying the plug register's value as style number, serial number, number of operations and trip history.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2-12, 14-14, 26-29 and 31-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (4,958,252). Murphy disclosed a circuit breaker with removable rating plug. The breaker includes a microprocessor (Fig.2, pos.27) for controlling a trip mechanism (25) of the breaker and a rating plug (7), containing the information about the plug in its

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EEPROM (memory) as well as in the value of precision resistors (43,45 and 47). It is well known in the art and obvious for ordinary skill artisan use of different kinds of memory (ROM, NVROM, RAM) and programs to compare and evaluate data from registers of EEPROM, containing characteristics of a plug with appropriate value and send a signal to trip mechanism accordingly. It is obvious also to use LAN or WWW instead of local programmer device, because it will enable implementation of central control and monitoring system.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1,13, 25 and 30 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,7, 12 and 16 of copending

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Application No. 09,682,512. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim: an electronic trip unit for circuit breaker comprising: a microprocessor, said microprocessor programmed to determine an overcurrent condition of said circuit breaker; a nonvolatile memory in electronic communication with said microprocessor; a module plug releasably engaged with said microprocessor, said module plug includes an identification register; wherein said microprocessor reads said identification register, said identification register including an identification number; wherein said microprocessor accesses one of a plurality of programs in said nonvolatile memory based said identification number; and wherein said one of a plurality of programs instructs said microprocessor to perform steps necessary to operate one or more functions of said module plug.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### **Contact information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Benenson whose telephone number is (703) 305-6917. The examiner can normally be reached on M-F (8:20-6:00) First Friday Off.

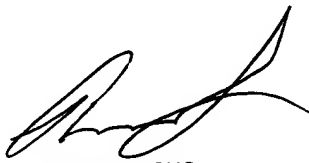
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (703) 308-3119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Boris Benenson  
Examiner  
Art Unit 2836

B.B.  
May 5, 2003



**BRIAN SIRCUS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2000**